

II. Rejections Under 35 U.S.C. § 103(a)

A. Dalle Taken with Zviak, Quack, or Mougin

The Examiner has maintained as unpatentable under 35 U.S.C. § 103(a) the rejection of (1) claims 1-18, 21, and 101-104 over European Patent No. EP 0874017 to *Dalle et al.* ("Dalle") taken with *The Science of Hair Care* 68-70 ("Zviak"), (2) claims 1-17, 19, 20, 22, 24, and 101-104 over *Dalle* in view of U.S. Patent No. 4,237,243 to *Quack et al.* ("Quack"), and (3) claims 1-19, 22, 23, 25-36, and 101-104 over *Dalle* in view of U.S. Patent No. 6,166,093 to *Mougin et al.* ("Mougin"). (Office Action dated February 12, 2002, page 2.) The Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition in *Dalle* by adding any of the thickeners in *Zviak*, *Quack*, or *Mougin* "because of the expectation to have produced cosmetic compositions with desired viscosity." (Office Action dated February 12, 2002, page 4, lines 13-16.) Applicants disagree with these rejections for at least the reasons of record and the additional reasons set forth below.

An obviousness rejection based on a combination of references requires the references to suggest the desirability of the combination. M.P.E.P. § 2143.01. The Examiner must make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have *selected* the components of the claimed invention *for combination* in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). And the Examiner must articulate a satisfactory explanation for the rejection, including a "rational connection between the facts found and the choice

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made." *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). Here, the facts relied on by the Examiner do not suggest the desirability of the proposed combination.

In previous office actions, the Examiner recognized that "[Dalle] lacks a specific mention of using non-cellulose thickener." (Office Action dated October 23, 2001, page 2, lines 21-22.) The Examiner, however, relying on *Dalle's* teachings of "conventional ingredients" and general utility in cosmetic applications, has alleged that it would have been obvious to add any of the non-cellulose thickeners of *Zviak*, *Quack*, or *Mougin* to *Dalle's* compositions. (Office Action dated May 9, 2001, page 4, lines 8-10.) But the term "conventional ingredients" is vague and too general a teaching to import thickeners, let alone non-cellulose thickeners, into *Dalle*.

In the instant Office Action, the Examiner relies on *Zviak*, *Quack*, and *Mougin* alleging that "so long as these references teach the thickening agents for the specific cosmetic applications taught in *Dalle* ... the obviousness rejection is proper." (Office Action dated February 12, 2002, page 5, lines 7-9.) Simply put, to unite the references the Examiner relies on the fact that the references teach similar applications. Thus, under this type of reasoning, any component useful in, for example, shampoo would be obvious to combine with any other component that is also useful in shampoo, even without incentive to combine them. But "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987) (citing *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)). Additionally, there must be some

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objective reason to combine references, which must also be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The fact that *Zviak*, *Quack*, and *Mougin* each teach a cosmetic application that is mentioned in *Dalle* does not satisfy the "clear and particular" standard. To establish a *prima facie* case of obviousness, it is incumbent upon the Examiner to explain why one of ordinary skill in the art would have selected at least one non-cellulose thickener for combination with at least one aqueous emulsion comprising at least one silicone copolymer.

Accordingly, Applicants respectfully request withdrawal of this rejection.

**B. Dalle and Mougin in Further View of Restle**

The Examiner has rejected claims 37-63 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in further view of U.S. Patent No. 6,039,936 to *Restle et al.* ("*Restle*"). Applicants respectfully traverse this rejection for the reasons already of record and for the additional reasons detailed below.

In previous office actions, the Examiner has alleged that it would have been obvious to add the cationic surfactants of *Restle* "because of the expectation to have produced compositions which would enhance penetration of actives and glossy appearance, and [softness] on hair, as taught by *Restle*." (Office Action dated May 9, 2001, page 7, lines 11-15.) For additional support, the Examiner has pointed to page 4, lines 21-37, of *Dalle*, which discloses some cationic surfactants. (Office Action dated October 23, 2001, page 5, lines 19-21.) *Dalle*, however, also teaches that some cationic surfactants can be irritating to the skin and can render some compositions

unstable. (*Dalle*, page 2, lines 17-20.) Thus, in light of these teachings, combining just any cationic surfactants, such as those of *Restle*, with the compositions of *Dalle* would not have been obvious to one of ordinary skill in the art. Accordingly, the Examiner must articulate a reason why one would have been led to incorporate the cationic surfactants of *Restle* into *Dalle*'s compositions. Unless and until the Examiner has done this, no *prima facie* case of obviousness can be made. Accordingly, Applicants respectfully request withdrawal of this rejection.

**C. *Dalle and Mougin in view of Decoster***

The Examiner has maintained the rejection of claims 64-100 under 35 U.S.C. § 103(a) as unpatentable over *Dalle* and *Mougin* in view of U.S. Patent No. 6,150,311 to *Decoster et al.* ("*Decoster*"). Applicants respectfully traverse this rejection for at least the reasons of record and for the additional reasons below.

In previous office actions, the Examiner has alleged that it would have been obvious to add the surfactants of *Decoster* to the composition of *Dalle* comprising the thickeners of *Mougin* "because of the expectation to have produced stable cleansing compositions for [keratinous] materials which retain the advantages of cosmetic properties of the actives, as taught by *Decoster et al.*" (Office Action dated May 9, 2001, page 8, lines 17-21.) But the Examiner "must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (emphasis supplied). Here, the Examiner has only provided a reason for

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selecting one of Applicants' claimed components; however, the Examiner must also articulate a reason to support the combination of this component with Applicants' other claimed components. As the Examiner has failed to establish a *prima facie* case of obviousness over the *Dalle/Mougini/Decoster* combination, Applicants respectfully request withdrawal of this rejection.

As the Examiner has failed to satisfy the burden under 35 U.S.C. § 103 with respect to any of the cited reference combinations, Applicants respectfully submit that all of the rejections under § 103 are improper and respectfully request their withdrawal.

**III. Obviousness-type Double Patenting Rejections**

The Examiner has provisionally rejected claims 1-104 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-84 of copending Application No. 09/692,360. In order to expedite prosecution of this application and without acquiescing to the double patenting rejection, Applicants file herewith a Terminal Disclaimer in accordance with 37 C.F.R. 1.321(c), disclaiming only the terminal portion of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of any patent granted on Application No. 09/692,360. Applicants respectfully reserve the right to argue the separate patentability of the pending claims over the claims of the prior patent, should that need ever arise.

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IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 7, 2002

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Attachment: Terminal Disclaimer

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